

reference which teaches that a significant synergistic effect is observed with the new antioxidant system based on at least one stabilized ascorbyl ester which includes at least one complexing agent and at least one thiol in combination therewith. The complexing agents can include ethylene diamine tetracetic acid (EDTA) (column 2, lines 4-7), and the thiol can include glutathion (column 2, lines 16-18). The N'Guyen reference also discloses that a significant synergistic effect occurs because of the presence of ascorbyl ester stabilized by the complexing agent - thiol couple (column 2, lines 49-53). In addition, the Example VI-solar cream relied on by the Examiner as showing the use of glutathion also discloses the presence of EDTA and ascorbic acid which components make up the new antioxidant system described and claimed in the N'Guyen reference.

In the final rejection the Examiner indicates on page 5, first paragraph, that

"On the current record there is no evidence that any of the additional ingredients present in the prior art composition would affect the basic and novel properties of the prior art composition such that the prior art composition is truly different than the claimed composition."

and Examiner's comment on page 6 that

"there is nothing in the reference indicating that the glutathion and the EDTA complexing agent were subject to conditions such that the two agents would be 'coupled' through

covalent bonding, or through electrostatic interaction, or any other type of bonding as alleged by applicant."

It is respectfully submitted that if the Examiner would refer to the stabilization study of ascorbyl palmitate referred to in column 8, line 6-34, it would become apparent that when ascorbyl palmitate and a thiol are combined with EDTA, the comparative tests demonstrated the stabilizing character of the complexing agent (EDTA) - thiol (N-acetyl cysteine) couple. Thus, the stabilization studies in the N'Guyen reference clearly demonstrate that the components making up the new antioxidant system of N'Guyen have been reacted and are effective (see also Fig. 1, particularly curve D).

It is thus apparent from the N'Guyen reference that the components in the solar cream, that is, the EDTA, glutathion, and ascorbyl palmitate react as described in the specification and claims of the N'Guyen reference. See, for example, Claim 1 which calls for an antioxidant system which includes an ascorbyl ester ethylene diamine tetracetic acid and glutathion. It is thus apparent that the final rejection fails to take into consideration the reference as a whole.

In In re Wesslau, 353 F2d 238, 147 USPQ 391 (CCPA, 1995), the CCPA in discussing rejections under 103 have indicated that "It is impermissible within the framework of 103 to pick and choose any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation

of what such a reference fairly suggests to one of skill in the art. See also Smith Kline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F2d 878, 887, 8 USPQ 2d 1468, 1475 (Fed.Cir., 1988) in which the court held that claims, the entire prior art, and prior art patents must each be read as a whole'".

It is therefore respectfully submitted that one of ordinary skill in the art in reading the N'Guyen reference would conclude that the glutathion present in the solar cream in Example VI would react with EDTA and form a new antioxidant system as described in the N'Guyen reference. Thus, the glutathion would not be present in the form of free glutathion, but, instead, reacts with EDTA to form the complexing agent - thiol couple as described in column 2, lines 50-53 of N'Guyen.

A second issue in this case is whether the final rejection ignores portions of the N'Guyen reference which "teach away" from the present invention. Applicants respectfully submit that the answer to this question is in the affirmative.

As outlined above, the N'Guyen reference discloses that the glutathion is part of the patentee's new antioxidant system which includes ascorbyl ester stabilized by a complexing agent - thiol couple. A complexing agent - thiol couple includes EDTA and glutathion reacted therewith (column 2, lines 45-53).

In the stabilization study of ascorbyl palmitate in column 8, lines 6-35, it is clear that when comparative studies were conducted, the combination of ascorbyl palmitate, EDTA, and thiol

produced the EDTA thiol-couple which produces the desired unexpected result as shown in Fig. 1., solution D. It is therefore obvious that these components react to produce the desired antioxidant effect as evidenced by the data in Fig. 1.

This portion of the N'Guyen reference "teaches away" from the present invention because the N'Guyen reference concludes that the glutathion is coupled, i.e, reacted with the coupling agent to form another compound, i.e, a complexing agent. As contrasted with the present invention where the glutathion is present in pure form and not reacted with EDTA to form the complexing agent.

In Phillips Petroleum Co. v. U.S. Steel Corp., 673 FSup 1278, 1315, 6 USPQ 2d 1065, 1093 (D.Del, 1987), aff'd 865 F2d 1247, 9 USPQ 2d 1461 (Fed.Cir., 1989), the court indicated that the prior art references relied upon must be considered in their entirety --- disclosures in the reference that diverge from and "teach away" from the invention cannot be disregarded.

In view of the foregoing, it is respectfully submitted that in the final rejection the Examiner has disregarded portions of the N'Guyen reference which "teach away" from the present invention by indicating that the glutathion is reacted with a complexing agent to form another compound and, therefore, glutathion is not present in its pure form. The Examiner has also ignored the fact that the N'Guyen reference discloses that these components react together, i.e., to form a complexing agent.

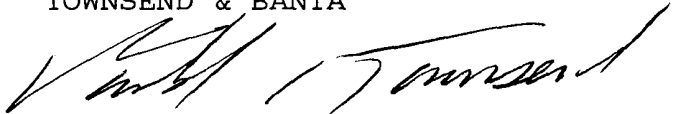
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In view of the foregoing, it is respectfully submitted that the rejections based on the N'Guyen reference fails as a matter of law in view of the above authorities. Consequently, the Examiner would be justified in no longer maintaining this rejection. Withdrawal of the rejection is accordingly respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action and allowance thereof is accordingly respectfully requested. In the event that there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted

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